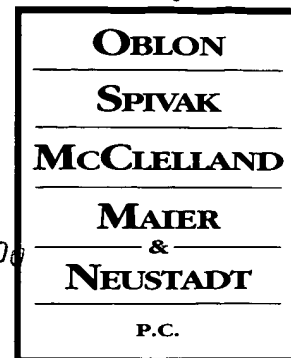




Docket No.: 201377US-3

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

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OCT 29 2002
TECHNOLOGY CENTER 2800



ATTORNEYS AT LAW

RE: Application Serial No.: 09/749,541
Applicants: Katsuhiko MAEDA
Filing Date: DECEMBER 28, 2000
For: LIGHT BEAM MAGNIFICATION ERROR AUTO
CORRECTING APPARATUS AND METHOD
Group Art Unit: 2861
Examiner: Hai Chi PHAM

SIR:

Attached hereto for filing are the following papers:

PROVISIONAL ELECTION OF SPECIES

Our check in the amount of \$0.00 is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Gay Ann Spahn

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Atty. Docket No.: 201377US-3

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

#13
Election
D. Smalls-Lagan
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RE APPLICATION OF

Katsuhiko MAEDA

SERIAL NO: 09/749,541

FILED: DECEMBER 28, 2000

FOR: LIGHT BEAM MAGNIFICATION
ERROR AUTO CORRECTING
APPARATUS AND METHOD

GROUP ART UNIT: 2861

EXAMINER: Hai Chi PHAM

PROVISIONAL ELECTION OF SPECIES

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

SIR:

In response to the Election of Species Requirement mailed on September 25, 2002, Applicant provisionally elects, with traverse, Species I, corresponding to the embodiment illustrated in FIGS. 2, 16, and 34, and identifies claims 15-35, 43-65, 68-77, 84, and 86-90 as readable on the provisionally elected species.

Applicant respectfully traverses the election requirement for several reasons.

First, the outstanding Official Action merely includes the conclusory statement that "the application contains claims directed to ... patentably distinct species ..." without stating any basis whatsoever in support of such a finding. This is in violation of the Manual of Patent Examining Procedure (hereinafter "MPEP") § 816 which states, as follows:

The particular reasons relied on by the examiner for holding the inventions as claimed are either independent or distinct should be concisely stated. A mere statement of conclusion is inadequate. The reasons upon which the conclusion is based should be given

In the absence of any annunciated basis, it is respectfully submitted that the PTO clearly has

In the absence of any annunciated basis, it is respectfully submitted that the PTO clearly has not carried forward its burden of proof to establish distinctness.

Secondly, MPEP § 806.04(f) requires, as follows:

Claims to be restricted to different species must be mutually exclusive . . .

The outstanding Official Action fails to address in any way whether the pending claims recite mutually exclusive characteristics and this failure provides a further basis for traversing the election requirement.

Finally, MPEP § 803 states, as follows:

. . . If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

The claims of the present invention would appear to be part of an overlapping search area. Accordingly, Applicant also respectfully traverses the outstanding Election requirement on the grounds that a search and examination of the entire application would not place a *serious* burden on the Examiner.

Therefore, it is respectfully requested that the requirement to elect a single species be withdrawn, and that a full examination on the merits of claims 15-90 be conducted.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Gay Ann Spahn

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